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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/589,638	08/16/2006	Yuichiro To	294145US8PCT	2296
22850 7590 03/05/2012 OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P. 1940 DUKE STREET ALEXANDRIA, VA 22314				
EXAMINER				
PHAM, KHANH B				
ART UNIT		PAPER NUMBER		
2166				
NOTIFICATION DATE		DELIVERY MODE		
03/05/2012		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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# Office Action Summary

**Application No.**

10/589,638

**Applicant(s)**

TO, YUICHIRO

**Examiner**

KHANH PHAM

**Art Unit**

2166

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ An election was made by the applicant in response to a restriction requirement set forth during the interview on \_\_\_\_; the restriction requirement and election have been incorporated into this action.
- 4) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 5) ☒ Claim(s) 16-18, 20-26, 28-34, 36 and 44-46 is/are pending in the application.
- 5a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 6) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 7) ☒ Claim(s) 16-18, 20-26, 28-34, 36 and 44-46 is/are rejected.
- 8) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 9) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 10) ☐ The specification is objected to by the Examiner.
- 11) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 12) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-806)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_
- Paper No(s)/Mail Date \_\_\_\_

**DETAILED ACTION**

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. **Claims 16-18, 20-26, 28-34, 36-42, 44-46** are rejected under 35 U.S.C. 103(a) as being unpatentable over Morohashi (US 2001/0030827 A1), hereinafter "**Morohashi**" and in view of Morohashi (US 2004/0223245 A1), hereinafter "**Morohashi-2**".

**As per claim 1**, Morohashi teaches an information processing apparatus comprising:

- "a networking device that communicates with an external apparatus" at Fig. 6;
- "a storage that stores an album of a plurality of content data and a transfer log indicating whether each of the plurality of content data has been transferred to the external apparatus" at [0124]-[0131]; and Fig. 5;
- "a processing unit configured to identify certain content data from the plurality of content data of the album when the transfer log indicates that certain content data has never been transferred to the external apparatus" at [0154]-[0170];
- "the processing unit further configured to control a display of information about the album, the processing unit further configured to start a transfer of the certain content data to the external apparatus, when the album has been selected and

the certain content data has never been transferred to the external apparatus" at [0154]-[0170] and Fig. 8;

- "and the processing unit further configured to update the transfer log when the networking device transfers the certain content data to the external apparatus" at [0147].

Morohashi does not explicitly teach identifying certain content data "upon a reception of a device ID of the external apparatus from the external apparatus" as claimed. However, Morohashi teaches at [0136] a similar system wherein the portable apparatus also has a unique ID for distinguishing the portable apparatus individually from others. Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to combine Morohashi's teachings so that "it is possible to create a list of programs applicable only to a specific portable recording and playback apparatus" as suggested by Morohashi-2 at [0136].

**As per claim 17**, Morohashi and Morohashi-2 teach the apparatus of claim 16 discussed above. Morohashi-2 also teaches: wherein "when the networking device receives the device ID from the external apparatus, the processing unit identifies the transfer log based on the device ID" at [0136].

**As per claim 18**, Morohashi and Morohashi-2 teach the apparatus of claim 16 discussed above. Morohashi also teaches: wherein "the processing unit is further configured to determine albums including the certain content data and to determine other content data held in the albums for a transfer to the external apparatus" at Fig. 8.

**As per claim 20**, Morohashi and Morohashi-2 teach the apparatus of claim 16 discussed above. Morohashi also teaches: wherein "the processing unit is further configured to cause a display device to display information about albums including the certain content data and, upon a selection of the albums in response to the displayed information, to transfer other content data from the selected albums to the external apparatus" at [0094]-[0096] and Figs. 5, 8.

**As per claim 21**, Morohashi and Morohashi-2 teach the apparatus of claim 20 discussed above. Morohashi also teaches: wherein "the processing unit is further configured to cause the display device to display the information about the albums based on the transfer log of the certain content data" at [0094]-[0096] and Figs. 5, 8.

**As per claim 22**, Morohashi and Morohashi-2 teach the apparatus of claim 16 discussed above. Morohashi also teaches: wherein "the processing unit is further configured to determine albums having only content data that has never been transferred to the external apparatus and to determine content data held in the albums to be transferred to the external apparatus" at [0154]-[0170] and Fig. 8.

**As per claim 23**, Morohashi and Morohashi-2 teach the apparatus of claim 22 discussed above. Morohashi also teaches: wherein "the processing unit is further

configured to determine the content data to be transferred to the external apparatus based on the transfer log" at [0154]-[0170] and Fig. 8.

**As per claim 24**, Morohashi and Morohashi-2 teach the apparatus of claim 16 discussed above. Morohashi also teaches: wherein "the processing unit is further configured to cause a display device to display information about albums having only content data that has never been transferred to the external apparatus and, upon a selection of the album in response to the displayed information, to transfer content data from the selected albums to the external apparatus" at [0094]-[0096] and Figs. 5, 8.

**As per claim 25**, Morohashi and Morohashi-2 teach the apparatus of claim 24 discussed above. Morohashi also teaches: wherein "the processing unit is further configured to cause the display device to display the information about the albums based on the transfer log" at [0094]-[0096] and Figs. 5, 8.

**As per claim 26**, Morohashi and Morohashi-2 teach the apparatus of claim 16 discussed above. Morohashi also teaches: wherein "the processing unit is further configured to acquire the transfer log from the external apparatus" at Figs. 6A-C.

**As per claim 28**, Morohashi and Morohashi-2 teach the apparatus of claim 16 discussed above. Morohashi also teaches; wherein "the certain content data is defined by a song" at [0004].

**As per claim 29**, Morohashi and Morohashi-2 teach the apparatus of claim 16 discussed above. Morohashi also teaches: wherein "the networking device transfers the certain content data to the external apparatus based on a determination whether the certain content data has previously been transferred to the external apparatus" at [0154]-[0170] and Fig. 8.

**As per claim 30**, Morohashi and Morohashi-2 teach the apparatus of claim 29 discussed above. Morohashi also teaches: wherein "the networking device transfers the certain content data to the external apparatus when the determination indicates that the certain content data has not previously been transferred to the external apparatus" at [0154]-[0170] and Fig. 8.

**Claims 31-34, 36-42, 44-46** recite similar limitations as in claims 16-18, 20-26, 28- 30 and are therefore rejected by the same reasons.

### ***Response to Arguments***

3. Applicant's arguments filed 2/7/2012 have been fully considered but they are not persuasive. The examiner respectfully traverses applicant's arguments.

Applicant argued that the Morohashi's 245 reference (US 2004/0223245 A1) is not qualify as prior art because the application entitles to the foreign priority date of February 25, 2004. The examiner respectfully submits that the earliest effective filing date of the Morohashi's 245 reference is September 20, 2000 (Division of application

09/665,786 filed on Sep. 20, 2000). Morohashi's 245 is therefore a proper 102(e) reference and the rejection based upon Morahashi is therefore sustain.

### ***Conclusion***

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KHANH PHAM whose telephone number is (571)272-4116. The examiner can normally be reached on Monday through Friday 7:30am to 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hosain Alam can be reached on (571) 272-3978. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Khanh B. Pham/  
Primary Examiner  
Art Unit 2166

February 28, 2012